

**Remarks:**

**Examiner Interview:**

Applicants and Applicants' representative appreciate the time and courtesy extended by the Examiner and his supervisor during the Examiner Interview conducted by telephone on May 5, 2010. The Examiner Interview was attended by Brett J. Rosen (Reg. No. 56,047), Examiner Robert Reese and Examiner John Nguyen. During the interview, Mr. Rosen and Examiner Reese discussed why it would not be obvious to combine the cited references, as presented in the Office Action, to arrive at the claimed invention recited in claims 7 and 16. The Examiners agreed with Mr. Rosen's position.

**Claim Status:**

Claims 7-9 and 11-16 are pending.

**Claim Rejections under 35 U.S.C. 103:**

Claims 7, 8, 11, 12 and 14-16 stand rejected as obvious over U.S. Patent No. 6,823,968 to Baeumler in view of and U.S. Patent No. 4,815,419 to Kitada and further in view of U.S. Patent App. Pub. No. 2003/0140888 to Tanaka . Applicants respectfully traverse the rejection of these claims and respectfully submit that these claims are patentable over the cited references for the reasons set forth hereinafter.

Page 4 of the Office Action acknowledges that Baeumler does not disclose **(1)** a main delivery pump configured for conveying lubricant oil from the wet sump oil supply container to consumer of the oil; and **(2)** a wet-sump oil supply container that is separate from the dry-sump oil suction space and positioned to at least partially surround the dry-sump oil suction space, at least a portion of the wet-sump oil supply container being disposed at an elevation beneath the dry-sump oil suction space.

Referring to Figure 2 of Baeumler, which is reproduced below, the Office Action implicitly contends that it would be obvious to position a main pump in Baeumler's oil collecting spaces 18/20 and reconfigure Baeumler's oil collecting spaces 18/20 to reside beneath Baeumler's oil suction space 16 in order to arrive at the claimed invention. Before discussing the reasons why there would be no reason to modify Baeumler as set forth in the Office Action, it is helpful to first consider the operation of Baeumler's engine (see also column 3, lines 3-16). In operation, oil that is taken away from the cylinder heads is returned by way of oil return ducts 38. The oil is then distributed in the oil collection spaces 18/20 via oil return pipes 30 and 32. Once a sufficient amount of oil has collected in oil collection spaces 18/20, the flaps 52 open (flaps shown closed) under the weight of the oil to permit the passage of oil into the oil suction space 16. The oil within oil suction space 16 is returned to consuming devices via oil suction pipe 17, which is positioned in oil suction space 16.

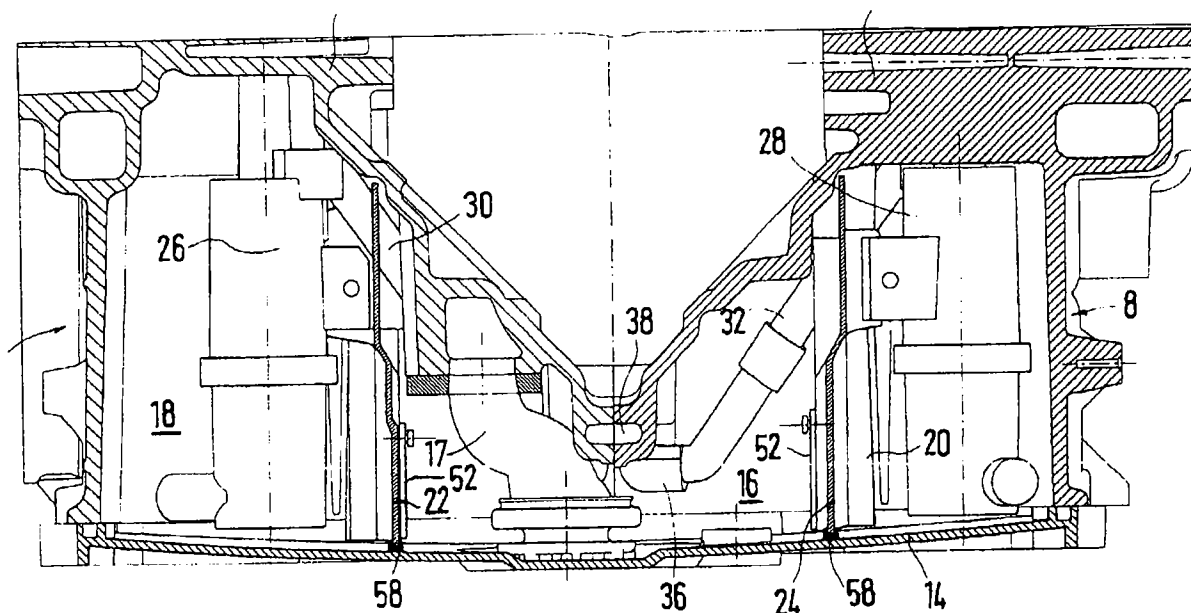


Fig. 2

For at least the following reasons, Applicants' respectfully submit that there would be no reason to modify Baeumler as set forth in the Office Action. First, if a main pump were to be positioned in Baeumler's oil collection spaces 18/20, the oil within oil collection spaces 18/20 would be immediately carried away by the main pump. Thus, a quantity of oil that is sufficient to open flaps 52 might not ever collect in oil collection spaces 18/20. If flaps 52 could not open under the weight of oil in oil collection spaces 18/20, then oil could not enter oil suction space

16 and oil suction pipe 17. Bypassing oil suction space 16 and oil suction pipe 17 would render Baeumler's engine unsatisfactory for its intended purpose because oil could not be delivered via pipe 17 to oil-consuming devices (as taught by Baeumler) or Kitada's annular space (as proposed on page 3 of the Office Action).<sup>1</sup>

Second, if Baeumler's oil collecting spaces 18/20 were reconfigured to reside beneath Baeumler's oil suction space 16, as proposed by the Office Action, then the oil might not collect in oil suction space 16. Reconfiguring Baeumler's oil collecting spaces 18/20 to reside beneath Baeumler's oil suction space 16 would cause the oil to collect in the reconfigured portion of oil collecting spaces 18/20 that resides beneath Baeumler's oil suction space 16, as opposed to the oil suction space 16. This is so because oil will collect at the point of lowest elevation. In other words, the oil suction space 16 would no longer be the point of lowest elevation to which oil is delivered under gravity. Applicants direct the Examiner's attention to the concave geometry of Baeumler's cover 14, which channels oil toward the lowest elevation pipe adjacent the snorkel of pipe 17. Moreover, the main pump that would be positioned in the reconfigured oil collection spaces 18/20 (as proposed by the Office Action) would distribute the oil to consuming devices, thereby bypassing oil suction space 16 and oil suction pipe 17. Bypassing oil suction space 16 and oil suction pipe 17 would render Baeumler's engine unsatisfactory for its intended purpose because oil could not be delivered via pipe 17 to oil-consuming devices (as taught by Baeumler) or Kitada's annular space (as proposed on page 3 of the Office Action).

Lastly, Applicants respectfully submit that the foregoing modifications to Baeumler's engine change the principle of operation of Baeumler's engine. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.<sup>2</sup>

For at least the foregoing reasons, Tanaka, Baeumler, and Kitada do not establish *prima facie* obviousness of independent claims 7 and 16. Reconsideration of claims 7, 8, 11, 12 and 14-16 is respectfully requested.

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<sup>1</sup> See MPEP 2143.01: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)"

<sup>2</sup> See MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Claims 9 and 13, which depend from claim 7, stand rejected as obvious over Tanaka, Baeumler, and Kitada, and further in view of U.S. Patent No. 5,215,316 to Udagawa. Udagawa generally relates to metal laminate gaskets used in open-deck engines. However, Udagawa does not supply any of the elements of claim 7 missing from the combination of Tanaka, Baeumler, and Kitada as detailed above. Thus the combination of Tanaka, Baeumler, Kitada, and Udagawa does not establish *prima facie* obviousness of claims 9 or 13, either.

**Conclusion:**

In view of the remarks above, Applicants respectfully ask for reconsideration and allowance of the pending claims. As discussed in the Examiner Interview, Examiner Reese is invited to contact Brett Rosen at 610-993-4245 in an effort to advance prosecution of this application.

Respectfully submitted,

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Jonathan H. Spadt, Reg. No. 45,122  
Brett J. Rosen, Reg. No. 56,047  
Attorneys for Applicants

JHS/BJR  
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P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

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